

REMARKS

I. Introduction

Claims 1-6, 9-13, 15-18 and 20 are pending in the present application. In view of the following remarks, it is respectfully submitted that claims 1-6, 9-13, 15-18 and 20 are allowable, and reconsideration is respectfully requested.

II. Rejections of Claims 1-3, 5-6, 9-12, 17 and 20 under 35 U.S.C. § 103(a)

Claims 1-3, 5-6, 9-12, 17 and 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,181,867 (“Kenner”) in view of U.S. Patent No. 5,923,817 (“Nakamura”).¹ Applicants respectfully submit that the rejection should be withdrawn for at least the following reasons.

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a *prima facie* case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, the Examiner must show, *inter alia*, that there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the references, and that, when so modified or combined, the prior art teaches or suggests all of the claim limitations. M.P.E.P. §2143. In addition, as clearly indicated by the Supreme Court, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. See KSR Int’l Co. v. Teleflex, Inc., 82 U.S.P.Q.2d 1385 (2007). In this regard, the Supreme Court further noted that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” Id., at 1396. To the extent that the Examiner may be relying on the doctrine of inherent disclosure in support of the obviousness rejection, the Examiner must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; see also Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)).

¹ The Examiner initially states that claims 1-3, 5-6, 9-11 and 20 are rejected in view of Kenner and Nakamura, but the Examiner also provides discussions of claims 12 and 17 under this ground of rejection.

Claim 1 recites the following:

1. A first digital video recorder-controller apparatus (DVRC), comprising:
 - a network port for communicatively connecting the first DVRC with at least one other apparatus on a network, wherein the network port is an ethernet port;
 - wherein the first DVRC is adapted to **transmit through the network port a first selection of digitized video signals**, wherein the first selection includes one or more digitized video signals being transmitted to a first other apparatus on the network;
 - and wherein the first DVRC is further adapted to **receive through the network port a second selection of digitized video signals**, wherein the second selection includes one or more digitized video signals being **transmitted by a second other apparatus on the network, wherein the second other apparatus is one of a digital video recorder (DVR) or a second DVRC**;
 - wherein the first DVRC is adapted to **facilitate designation of the digitized video signals of the second selection**, and wherein the first DVRC is further adapted to **transmit a first control signal to the second other apparatus, wherein the first control signal designates the one or more video signals of the second selection of digitized video signals** to be transmitted by the second other apparatus.

Independent claims 12 and 17 recite substantially similar features as the above-recited features of claim 1.

In support of the rejection of independent claims 1, 12 and 17, the Examiner contends that PIM 22 shown in Fig. 1 of Kenner satisfies the above-recited limitations regarding the “first digital video recorder-controller apparatus (DVRC).” However, there is no reasonable interpretation of the claimed limitations and the actual teachings of Kenner that would support the Examiner’s contention, as explained in detail below.

First, PIM 22 of Kenner is clearly described as an “index manager,” which merely locates video clips requested by a user and creates a list of the located video clips, and there is no suggestion in Kenner that PIM 22 is any sort of a “digital video recorder,” let alone a “digital video recorder-controller apparatus.” Second, even if one assumes for the sake of argument that PIM 22 can somehow be considered as a “digital video recorder-controller apparatus,” which is clearly no the case, the PIM 22 of Kenner clearly does not satisfy the

limitations regarding transmitting of first selection of video signals through the network port of the first DVRC, receiving of second selection of video signals through the network port of the first DVRC, and transmitting of a first control signal to designate the video signals of the second selection. As clearly described in column 13 and Fig. 3 of Kenner, PIM 22 does not actually transmit or receive video signals, but merely performs the following: (a) creates and downloads an initial list of all available video clips in response to the user's initial requested query; and (b) based on the user's narrowed selection made from the initial list of available video clips, PIM 22 creates a DSI (data sequencing interface) and communicates to the DSI the storage location of the requested video clip. (Kenner, col. 13, l. 33-61). In turn, using the storage location information, the DSI handles the collection and sending of the selected video clips to the user terminal 14. (Kenner, col. 13, l. 61 – col. 14, l. 11). Accordingly, PIM 22 of Kenner clearly does not transmit a first selection of video signals through the network port of the first DVRC, receive a second selection of video signals through the network port of the first DVRC, and transmit a first control signal to designate the video signals of the second selection.

In addition to the above, the teachings of secondary Nakamura reference simply do not remedy the above-described deficiencies of Kenner as applied against claims 1, 12 and 17.

For at least the foregoing reasons, independent claims 1, 12 and 17, as well as dependent claims 2-3, 5-6, 9-11, and 20, are patentable over the overall teachings of Kenner and Nakamura.

III. Rejection of Claims 1-6, 9-13, 15-18 and 20 under 35 U.S.C. § 103(a)

Claims 1-6, 9-13, 15-18 and 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,002,995 (“Suzuki”) in view of U.S. Patent No. 6,891,566 (“Marchese”). Applicants respectfully submit that the rejection should be withdrawn for at least the following reasons.

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a *prima facie* case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, the

Examiner must show, *inter alia*, that there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the references, and that, when so modified or combined, the prior art teaches or suggests all of the claim limitations. M.P.E.P. §2143. In addition, as clearly indicated by the Supreme Court, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. See KSR Int’l Co. v. Teleflex, Inc., 82 U.S.P.Q.2d 1385 (2007). In this regard, the Supreme Court further noted that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” Id., at 1396. To the extent that the Examiner may be relying on the doctrine of inherent disclosure in support of the obviousness rejection, the Examiner must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; see also Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)).

Claim 1 recites the following:

1. A first digital video recorder-controller apparatus (DVRC), comprising:
 - a network port for communicatively connecting the first DVRC with at least one other apparatus on a network, wherein the network port is an ethernet port;
 - wherein the first DVRC is adapted to **transmit through the network port a first selection of digitized video signals**, wherein the first selection includes one or more digitized video signals being transmitted to a first other apparatus on the network;
 - and wherein the first DVRC is further adapted to **receive through the network port a second selection of digitized video signals**, wherein the second selection includes one or more digitized video signals being **transmitted by a second other apparatus on the network, wherein the second other apparatus is one of a digital video recorder (DVR) or a second DVRC**;
 - wherein the first DVRC is adapted to **facilitate designation of the digitized video signals of the second selection**, and wherein the first DVRC is further adapted to transmit **a first control signal to the second other apparatus, wherein the first control signal designates the one or more video signals of**

the second selection of digitized video signals to be transmitted by the second other apparatus.

Independent claims 12 and 17 recite substantially similar features as the above-recited features of claim 1.

In support of the rejection of independent claims 1, 12 and 17, the Examiner contends that the following portions of Suzuki teach the above-recited claimed limitations of the “first digital video recorder-controller apparatus (DVRC)”: Fig. 6; col. 2, l. 38-50; col. 4, l. 35-65; and col. 5, l. 50 – col. 6, l. 38). However, Applicants respectfully submit that the actual teachings of Suzuki do not support the Examiner’s contentions, as explained below.

First, contrary to the Examiner’s contention that element 40 of Suzuki is equivalent to the claimed “first digital video recorder-controller apparatus (DVRC),” Suzuki merely indicates that element 40 is “a monitoring terminal operated by the user as an observer,” and that the “[o]ther terminals 42 and 44 are video transmission terminals for transmitting an image or images . . . to the monitoring terminals 40.” (Col. 5, l. 27-40). Accordingly, terminal 40 clearly doesn’t “**transmit through the network port a first selection of digitized video signals**, wherein the first selection includes one or more digitized video signals being transmitted to a first other apparatus on the network,” as recited in claim 1 (and similarly recited in claims 12 and 17). Second, there is no suggestion in Suzuki that terminal 40 is a “digital video recorder,” let alone a “digital video recorder-controller apparatus.”

In addition to the above, the teachings of secondary Marchese reference simply do not remedy the above-described deficiencies of Suzuki as applied against claims 1, 12 and 17.

For at least the foregoing reasons, independent claims 1, 12 and 17, as well as dependent claims 2-6, 9-11, 13, 15, 16, 18 and 20, are patentable over the overall teachings of Suzuki and Marchese.

CONCLUSION

In view of all of the above, it is respectfully submitted that all of the presently pending claims are in allowable condition. Prompt reconsideration and allowance of the application are respectfully requested.

Respectfully submitted,



(R. No.
36,197)

Dated: 5/27, 2010

By: JONG LEE for Gerard Messina
Gerard A. Messina (Reg. No. 35,952)
KENYON & KENYON LLP
One Broadway
New York, New York 10004
(212) 425-7200

CUSTOMER NO. 26646